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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,800	12/09/2003	Raymond F. Watts	2003L008	4327

7590 02/23/2007  
Infineum USA L.P.  
Law Department  
1900 East Linden Avenue  
P. O. Box 710  
Linden, NJ 07036-0710

EXAMINER
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GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/731,800

Applicant(s)

WATTS ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Watts (Pat. No. 6,337,309).

The rejection is adequately set forth in paragraph 2 of the office action mailed 11/15/2006 and is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

2. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Kinoshita (U.S. Pat. No. 4,396,516).

The rejection is adequately set forth in paragraph 5 of the office action mailed 11/15/2006 and is incorporated here by reference.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Kinoshita as applied to claims 1-3 and 6 above, and further in view of Srinivasan (U.S. Pat. No. 5,578,236).

The rejection is adequately set forth in paragraph 6 of the office action mailed 11/15/2006 and is incorporated here by reference.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Kinoshita as applied to claim 1-3 and 6 above, and further in view of Ohtani (U.S. Pat. No. 5,344,579).

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The rejection is adequately set forth in paragraph 7 of the office action mailed 11/15/2006 and is incorporated here by reference.

5. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Kinoshita as applied to claim 1-3 and 6 above, and further in view of Bloch (U.S. Pat. No. 5,597,506).

The rejection is adequately set forth in paragraph 8 of the office action mailed 11/15/2006 and is incorporated here by reference.

### ***Response to Arguments***

6. Applicant's arguments filed 11/20/2006 have been fully considered but they are not persuasive.

Applicant argues that claim 1 is distinguished from the Watts '309 reference because the succinimides of claim 1 are formed from a reaction involving a monoamine, not the polyamines of Watts, and are therefore monosuccinimides rather than di-succinimides. However, claim 1 recites a primary aliphatic amine of the formula  $R-NH_2$  where R is a  $C_4-C_{30}$  hydrocarbyl group. On page 7 lines 11-25 of the specification, applicant defines a hydrocarbyl group as a group having predominantly hydrocarbon character, and which can contain substituted hydrocarbon groups and heteroatoms, where the list of substituted groups does not exclude amines, and nitrogen is listed as a suitable heteroatom. The polyamines of Watts '309 clearly fall within this definition, as

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the R group remains predominantly hydrocarbon despite containing an extra amine group, and contains nitrogen as a heteroatom.

Applicant argues that one of ordinary skill in the art would not have been motivated to combine the references of Watts and Kinoshita because Watts teaches an imide friction modifier while Kinoshita teaches an imide base lubricant. It is the examiner's position that based on the teaching of Kinoshita that the imide lubricant has superior friction reducing properties than standard base oils, one of ordinary skill in the art would have realized that a blend of the imide of Kinoshita and the lubricating oil of Watts would possess improved friction reducing characteristics when used for lubricating non-ferrous surfaces. It is also noted that lubricant blends are common in the art, and the fact that Kinoshita discloses the imide as a base lubricant does not discourage in any way its blending with another base lubricant.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*James C. Goloboy*  
JCG

*Vasu Jagannathan*  
VASU JAGANNATHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700